

REMARKS

Claims 1-24 are currently pending in the subject application and are presently under consideration. A version of all pending claims is presented on pages 2-7 of this Reply. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments herein.

I. Rejection of Claim 23 Under 35 U.S.C. §101

Claim 23 stands rejected under 35 U.S.C. §101 as because it is alleged that the claimed invention is directed to non-statutory subject matter. Withdrawal of this rejection is requested for at least the following reasons. Claim 23 produces a useful, concrete and tangible result, and the subject claim pertains to transmission of software code between two or more computer processes.

Because the claimed process applies the Boolean principle [abstract idea] *to produce a useful, concrete, tangible result* ... on its face the claimed process comfortably falls within the scope of §101. *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358. (Fed. Cir. 1999) (Emphasis added); *See State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601 (Fed.Cir.1998). The inquiry into patentability requires an examination of the contested claims to see if the claimed subject matter, as a whole, is a disembodied mathematical concept representing nothing more than a "law of nature" or an "abstract idea," or if the mathematical concept has been *reduced to some practical application rendering it "useful."* *AT&T* at 1357 citing *In re Alappat*, 33 F.3d 1526, 31 1544, 31 U.S.P.Q.2D (BNA) 1545, 1557 (Fed. Cir. 1994) (emphasis added).

The Examiner contends: "[a] communications signal transmitting between two computers a data packet is not tangible." Applicants' representative disagrees and submits the Examiner is misconstruing the requirements necessary to fulfill the conditions for patentability under 35 U.S.C. §101. According to *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352 (Fed. Cir. 1999), the standard set forth by the Federal Circuit for determining whether claims are directed towards statutory subject matter is whether the claims as a whole can be applied in a practical application to

produce a useful, concrete and tangible result. It is the result of the claims as applied in a practical application that is germane to the determination of whether the claims are directed towards statutory subject matter, not whether the underlying means by which the result is effectuated that should be tangible, as the Examiner intimates. It is believed therefore that the subject claim clearly satisfies this legal standard. In particular, independent claim 23 recites: *a data packet transmitted as a communication signal between at least two computer processes, comprising: a configurable module having: one or more configurable data elements, wherein one or more default values for the one or more configurable data elements are available; one or more non-configurable data elements describing the one or more configurable data elements; and one or more transformation instructions that facilitate configuring the one or more configurable data elements, wherein the instructions are employed to facilitate installation of the one or more configurable data elements into a target data set residing in at least one of the at least two computer processes.* Thus, claim 23 elicits a series of independent acts that culminates in a useful, concrete and tangible result – the installation of the one or more configurable data elements into a target data set residing in at least one of the at least two computer processes.

Additionally, the Court of Appeals for the Federal Circuit stated in *Eolas Techs., Inc. v. Microsoft Corp.*, 399 F.3d 1325 (Fed. Cir. 2005):

Title 35, section 101, explains that an invention includes "any new and useful process, machine, manufacture or composition of matter." ... Without question, *software code alone qualifies as an invention eligible for patenting under these categories*, at least as processes. *Id.* at 1338 (emphasis added).

The subject claim clearly pertains to software code comprising a configuration module, one or more configurable data elements, one or more non-configurable data elements, and one or more transformation instructions encapsulated in a data packet transmitted from one computer process to another computer process, so that the transformation instructions contained therein can be employed to facilitate installation of one or more configurable data elements into a target data set residing in at least one of the at least two computer processes. The fact that (i) the data packet that encases the

software code during its transmission between two processes, or (ii) the data packet is transmitted as a communication signal between two processes is irrelevant to the fact that it is software code that is contained therein and is being transmitted through utilization of a communication signal. It is submitted that all that is relevant is the fact that software code is being transmitted within the data packet, and that the software code so transmitted produces a useful, concrete and tangible result.

Moreover, the Examiner alleges that the claim is directed to a signal directly or indirectly by claiming a medium and the Specification recites evidence where the computer readable medium is defined as a “wave” (such as a carrier wave), and as such are directed towards a form of energy, which at present the office feels does not fall into a category of invention. The Examiner in order to substantiate this position requests applicants’ representative to review the office’s current policy at the proffered URL (United States Patent and Trademark Office (USPTO) policy on 35 U.S.C. §101). (See Office Action dated June 20, 2006, page 2). Applicants’ representative having perused the information supplied at the aforementioned URL notes that the policy states that the “**Guidelines do not** constitute substantive rulemaking and hence **do not have the force and effect of law.**” (Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, page 2 (emphasis added)). It is thus applicants’ contention that while the Patent and Trademark Office is entitled to adopt, promulgate, and implement any policy that it so chooses in satisfying its mandate and to provide guidance on the statute and the Federal Court’s interpretation thereof, the policy so adopted must be in accord with the Court’s statutory interpretation. Additionally, it is applicants’ further contention that current Patent and Trademark Office policy with respect to carrier waves is clearly at variance with the interpretation of the Federal Courts in this matter.

To date, the Federal Courts, in particular the Supreme Court, in interpreting the ambit of 35 U.S.C. §101 have observed that Congress intended 35 U.S.C. §101 to include “anything under the sun that is made by man.” *Diamond v. Chakrabarty*, 447 U.S. 303, 309 (1980) quoting S.Rep. No. 1979, 82nd Cong., 2nd Sess., 5 (1952). However, despite the broad interpretive scope set forth, the Supreme Court, admittedly, has held that certain categories of subject matter are not entitled to patent protection. In *Diamond v.*

Diehr, 450 U.S. 175 (1981) the Supreme Court explained that there are three recognized categories of subject matter for which one may not obtain patent protection, namely “laws of nature, natural phenomena, and abstract ideas.” *Id.* at 185. Subsequent decisions from Federal Circuit have not further limited or expanded these exclusionary categories.

As has been stated *supra*, according to *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352 (Fed. Cir. 1999), the legal standard set forth by the Federal circuit for determining whether claims are directed towards statutory subject matter is whether the claims can be applied in a practical application to produce a useful, concrete and tangible result. In *AT&T*, the patent at issue described a message record for long-distance telephone calls that included a primary interexchange carrier (“PIC”) indicator, which allowed for differential billing treatment for subscribers. (See *AT&T*, 172 F.3d at 1353). AT&T’s claimed process applied Boolean algebra “to determine the value of the PIC indicator, and [applied] that value through switching and recording mechanisms to create a signal useful for billing purposes.” (See *AT&T*, 172 F.3d at 1358). Relying on its holdings in *State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368 (Fed. Cir. 1998), *cert. denied*, 525 US 1093 (1999) and *Arrhythmia Research Tech. Inc. v. Corazonix Corp.*, 958 F.2d 1053 (Fed. Cir. 1992), the Court held that the AT&T process was patentable subject matter:

In *State Street*, we held that the processing system there was patentable subject matter because the system takes data representing discrete dollar amounts through a series of mathematical calculations to determine a final share price – **a useful, concrete, and tangible result**. See 149 F.3d at 1373, 47 USPQ2d at 1601. In this case, Excel argues, correctly, that the PIC indicator value is derived using a simple mathematical principle (p and q). But that is not determinative because AT&T does not claim the Boolean principle as such or attempt to forestall its use in any other application. It is clear from the written description of the ‘184 patent that AT&T is only claiming a process that uses the Boolean principle in order to determine the value of the PIC indicator. The PIC indicator represents **information** about the call recipient’s PIC, **a useful, non-abstract result** that facilitates differential billing of long-distance calls made by an IXC’s subscriber. Because the claimed process applies the Boolean

principle to produce a ***useful, concrete, tangible result*** without pre-empting other uses of the mathematical principle, on its face the claimed process comfortably falls within the scope of Section 101. *See Arrhythmia Research Tech. Inc. v. Corazonix Corp.*, 958 F.2d 1053, 1060, 22 USPQ2d 1033, 1039 (Fed. Cir. 1992) (“That the product is numerical is not a criterion of whether the claim is directed to statutory subject matter.”). *See AT&T*, 172 F.3d at 1358 (emphasis added).

In *Arrhythmia*, electrocardiograph signals were input into a computer and filtered and analyzed to determine the average magnitude of the signals. The resulting output signal was then compared to a predetermined level to determine whether the patient was at high risk for a particular arrhythmia. The Court found the claims patentable subject matter stating:

The resultant output is not an abstract number, but is a ***signal*** related to the patient's heart activity. These claimed steps of “converting”, “applying”, “determining”, and “comparing” are physical process steps that transform one ***physical, electrical signal*** into another. ***The view that “there is nothing necessarily physical about ‘signals’ is incorrect.*** *In re Taner*, 681 F.2d 787, 790, 214 USPQ 678, 681 (CCPA 1982) (holding statutory claims to a method of seismic exploration including the mathematically described steps of “summing” and “simulating from”). . . . The computer-performed operations transform a particular input ***signal*** to a different output ***signal***, in accordance with the internal structure of the computer as configured by electronic instructions. “The claimed invention . . . converts one ***physical thing*** into another ***physical thing*** just as any other electrical circuitry would do”. *Arrhythmia*, 958 F.2d at 1059, 1060 (citations omitted) (emphasis added).

In *State Street*, the Federal Circuit remarked upon its decision in *Arrhythmia* and noted that the transformation of electrocardiographic signals was patentable as “a practical application of an abstract idea . . . because it corresponded to a useful, concrete or tangible thing – the condition of a patient's heart.” (*State Street*, 149 F.3d at 1373). The Federal Circuit also remarked in *State Street* that:

We note that, for the purposes of a Section 101 analysis, it is of little relevance whether [a claim] is directed to a “machine” or a

“process,” as long as it falls within at least one of the four enumerated categories of patentable subject matter *State Street*, 149, F.3d at 1373.

As noted above, the Federal Circuit case law supports the contention that carrier waves/signals fall within at least one of the four enumerated categories of patentable subject matter. The Federal Circuit has made clear that signals are physical things, (see *Arrhythmia*, 958 F.2d at 1059, 1060), and as such carrier signals/waves are not naturally occurring phenomena, but rather, manufactured signals which accordingly are patentable products of manufacture in and of themselves. Consequently, in view of the Federal Circuit’s holdings with regard to carrier waves/signals it is believed that the Patent and Trademark Office policy that the Examiner is attempting to propound is not in accord with the Federal Courts interpretation of the requirements set forth in Title 35 of the United States Code. Thus, it is submitted that a claim drawn to a data packet transmitted as a communication signal falls squarely within the ambit of statutory subject matter under 35 U.S.C. §101, and thus should be afforded patent protection regardless of a Patent and Trademark Office policy that is demonstrably erroneous and neither reflective of, nor in accord with, the Federal Courts interpretation in this matter. Accordingly, withdrawal of this rejection is requested.

II. Rejection of Claims 1-24 Under 35 U.S.C. §102(b)

Claims 1-24 stand rejected under 35 U.S.C. §102(b) based upon a public use or sale of the invention, Microsoft (Assignee) Visual Source Safe (VSS) published 1997. This rejection should be withdrawn for at least the following reasons. The cited document does not disclose or suggest all features recited in the subject claims.

A single prior art reference anticipates a patent claim only if it *expressly or inherently describes each and every limitation set forth in the patent claim*. *Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 USPQ2d 1597 (Fed. Cir. 2002); *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The *identical invention must be shown in as complete detail as is contained in the ...*

claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

Applicants' claimed subject matter relates to systems and methods for configuring software components that can be incorporated into computer programs, and more particularly, to creating, describing and configuring software components (that are data sets) that are to be incorporated into software programs (target data sets) such that the components are self-describing in relation to configuration possibilities for the software component. An advantage of the subject matter as claimed for example, is that consumers of particular software components to be incorporated into particular applications will have available substantially all data necessary to effect installation of the component as compared to having to gather disjoint data, as is presently the situation. Additionally, the claimed subject matter simplifies and permits automating the creation of program installation data sets. To this end, independent claim 1 (and similarly, independent claims 9, 13, 17, and 22-23) recites: ***one or more non-configurable data elements describing the one or more configurable data elements.*** The Visual Source Safe document does not disclose or suggest this pertinent aspect of the claimed subject matter.

The cited document relates to a software source control or version control package that manages multiple revisions/versions of the same unit of information. Version or source control software typically is employed in software development contexts to manage ongoing development of digital documents such as application source code that may be worked on by a team of people. The Examiner contends the cited document discloses, at pages 89-95 and 114, non-configurable data elements that describe the configurable data elements. Applicants' representative respectfully disagrees. Pages 89-95 in summary relate to a file differences function that informs the user of the differences that exist between two files, *i.e.*, determines what has changed between one version of the file to the next version of the file. (*See e.g.*, page 90, line 3). Moreover page 114, contrary to the Examiner's indication, makes not mention whatsoever, of binary files that "describe one or more configurable data elements binary format being compiled or linked in object code format – describing the source which is

configurable". (See, Office Action dated June 20, 2006, page 3). Rather, page 114 provides that the Visual merge method is visually complex, and the most important element of understanding the Visual merge is mastering its interface. Additionally, page 114 provides that the Visual merge dialog does not provide a menu bar, but rather presents icons and buttons that have to be used to navigate through the dialog, one difference (a point where a change is present in one file, but not the other) and one conflict (a line of text where both files have a different entry, and Visual Source Safe cannot decide which one to use) at a time. It is thus submitted, the cited document does not disclose or suggest one or more non-configurable data elements describing the one or more configurable data elements as recited by the subject claims. Nowhere in the cited document is this salient aspect of the claimed subject matter disclosed or suggested. Accordingly, withdrawal of this rejection with respect to independent claims 1, 9, 13, 17, and 22-23 (and claims that depend there from) is requested.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063[MSFTP139USA].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number below.

Respectfully submitted,
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